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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/719,221 02/16/01 HUBLER

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023599 HM12/0619
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EXAMINER

NGUYEN, H

ART UNIT

PAPER NUMBER

1617

DATE MAILED:

06/19/01

Please find below and/or attached an Office communication-concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/719,221

Applicant(s)

HUBLER ET AL.

Examiner

Helen Nguyen

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-12 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.

- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 1617

DETAILED ACTION

The claimed priority of this application to German Application No. 19825591.8, filed on June 09, 1998, through PCT/DE99/01652, filed on June 07, 1999 under 37 U.S.C. 371, is acknowledged.

Preliminary amendment B, filed on May 22, 2001, in Paper No. 8 is acknowledged.

Applicant's election with traverse of gestagen, component A₁ (claim 4), in Paper No. 7 is acknowledged. The traversal is on the ground(s) that there is a common technical feature in all claims. This is not found persuasive because each specie has a unique mode of action, different from the others.

The requirement is still deemed proper and is therefore made FINAL.

Claim 6 have been canceled.

Claims 5 and 7-11 are non-elected.

Claims 1-4 and 12 are presented for examination.

Abstract objection

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim rejection

The following is a quotation of the appropriate paragraphs of **35 U.S.C. 102** that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-4 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen (WO 91/00095).

Cohen teaches a method of preventing prostate cancer in men comprising administering a combination of androgenic hormone with gestagenic hormone.

Testosterone, fluoxymesterone and levonorgestrel are disclosed. See abstract, claims 39, 41 and 43. Cohen also teaches the hormones can be administered orally, parenterally and by implant. Tablets and capsules are also disclosed. See page 9, lines 30-32, page 10, lines 10-15 and line 28.

As to the claimed compensation of testosterone deficiency such is inherently achieved by the administration of the agent itself.

Claims 1-4 and 12 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen Nguyen whose telephone number is (703) 605-1198. The examiner can normally be reached on M-F (9:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Edward J. Webman can be reached on (703) 308-4432, or supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Application/Control Number: 09/719,221

Page 4

Art Unit: 1617

Helen Nguyen
Patent Examiner

June 15, 2001

EDWARD J. WEBMAN
PATENT EXAMINER
GROUP 1500